

**REMARKS**

In response to the Final Office Action mailed January 6, 2009 (hereinafter, "Office Action")<sup>1</sup>, the response for which is due on April 6, 2009, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

**I. Status and Disposition of the Claims**

In the instant Application, claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-125 are currently pending. Of these pending claims, claims 21, 50 and 79 are independent. In the Office Action, the following actions were taken<sup>2</sup>:

- claims 21-39, 41-45, 47-49, and 123 were rejected under 35 U.S.C. § 101;
- claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-125 were rejected under 35 U.S.C. § 112, first paragraph<sup>3</sup>;
- claims 21-27, 50-56, 79-85, and 123-125 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,021,397 to Jones et al (hereinafter, "Jones")<sup>4</sup>;
- claims 28-39, 41-45, 47-49, 57-68, 70-74, 76-78, 86-97, 99-103, and 105-107 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jones;

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

<sup>2</sup> Applicant notes that Office Action treated claim 75 as pending. However, claim 75 had been canceled by a previous amendment. Therefore, Applicant believes the discussions of the rejections were not intended to apply to claim 75, and Applicant responds herein accordingly.

<sup>3</sup> Applicant notes that the Office Action lists the claims rejected under 35 U.S.C. § 112, first paragraph in two locations, one on page 3, and the other on page 7. Both lists contain claim 75, which was previously cancelled, and the citation on page 7 lists claim 69, which has also previously been canceled. Therefore, Applicant believes the discussion of the rejection was not intended to apply to claim 69, and Applicant responds herein accordingly.

<sup>4</sup> Applicant notes that the Office Action contains two sections addressing the rejection under 35 U.S.C. § 102(e). The first section, at pages 7-13, quotes the claim language pending at the time of the mailing of the Office Action. The second section, at pages 27-32, quotes the claim language pending at the time of the mailing of the previous Office Action of July 14, 2008. Therefore, Applicant believes the discussion of the rejection at pages 7-13 was intended to apply, and Applicant responds herein accordingly.

- Applicant notes with gratitude that the rejection of claims 50-68, 70-74, 76-78, and 124 under 35 U.S.C. § 101 has been withdrawn; and
- Applicant notes with gratitude that the rejection of claims 50-68, 70-74, 76-97, 99-103, 105, 124, and 125 under 35 U.S.C. § 112, second paragraph has been withdrawn.

## **II. Amendments to Claims and New Claims**

In this Amendment and Response, claims 21, 24-27, 41, 42, 44, 47-50, 70, 71, 73, 77, 79, 99, 100, 102, 106, 107 and 123 have been amended to place them in condition for allowance. Many of the amendments add missing antecedent basis or improve readability. Claims 50 and 79 were amended to complete the removal of the “means” and “module” language that was deleted in the Reply to Office Action that was submitted on October 8, 2008 (hereinafter, “the Previous Office Action Reply”). Claim 123 was amended to bring its preamble in conformance with the other claims depending from claim 21. In addition, claims 126-134 have been added.

Support for the claims amendments and for the new claims may be found in the specification, among other locations, at page 29, lines 28-30; page 30, lines 11-17; page 30, line 23 to page 31, line 2; page 31, lines 8-11; page 32, lines 26-28; page 33, lines 8-9; and page 36, lines 6-10 and 18-20. These passages, in conjunction with the figures and pending claims, provide written description of the subject matter of the amendments in the amended claims and in new dependent claims 126-134.

Applicants submit that the proposed new claims 126-134 do not necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships as claimed were either earlier claimed or inherent in the claims as examined.

Upon entry of the amendments and the new claims, claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-134 will be pending in this application.

### **III. Response to Rejections**

In light of the foregoing amendments and based on the reasoning presented below, Applicant respectfully traverses the rejections of the pending claims under 35 U.S.C §§ 101, 102(e), 103(a), and 112, first paragraph, requests removal of the application from final condition, and requests allowance of the pending claims.

#### **A. The Rejection of the Claims under 35 U.S.C. § 101 Should be Withdrawn.**

In the Office Action, claims 21-39, 41-45, 47-49, and 123 were rejected under 35 U.S.C. § 101, due to the allegation that “the claimed invention is directed to non-statutory subject matter.” Office Action at 6. While Applicant disagrees with the Office Action’s characterization of the claims, to advance prosecution, Applicant has nevertheless amended independent claim 21 to recite, *inter alia*,

- “providing a system comprising at least one memory to store data and instructions, a display device, a user interface, at least one processor having distinct software modules configured to access the at least one memory and, when executing the instructions, to perform . . . computer-implemented steps”;
- “receiving, via the user interface, information”;
- “allowing the user to select at least one goal . . . via the user interface”; and
- “allowing the user, via the user interface, to make an adjustment to user preferences.”

Claims 22-39, 41-45, 47-49, and 123 depend from independent claim 21, and they include all the limitations thereof. In addition, claims 24-27, 41, 42, 44, and 47-49

have also been amended to contain additional claim elements that further tie the computer-implemented methods therein recited to specific machines. Thus, claims 21-39, 41-45, 47-49, and 123 recite methods tied to specific machines. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 21-39, 41-45, 47-49, and 123 under 35 U.S.C. § 101.

**B. The Rejection under 35 U.S.C. § 112, First Paragraph Should be Withdrawn.**

Applicant respectfully traverses the rejection of claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 112, ¶ 1, for allegedly “failing to comply with the written description requirement.” Office Action at 7. The Office Action states that, “[t]he claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” *Id.* at 7.

As to independent claims 21, 50 and 79, the Office Action states that “[t]he specification does not appear to provide any support for ['an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals'], nor has Applicant attempted to point where the claim is supported.” *Id.*

As to claims 123-125, the Office Action states that “[t]he specification does not appear to provide any support for ['generating a profile of the user based on the adjusted user preferences and personal information of the user . . .'], nor has Applicant attempted to point where the claim is supported.” *Id.*

Applicant respectfully disagrees with the Office Action’s characterization of the claims as lacking written description in the specification. M.P.E.P. § 608.01(o) states, “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import.” Further, “[t]here is no requirement that the words in the claim must match those used in the specification disclosure.” M.P.E.P. § 2173.05(d).

- **Claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, and 105-107**

Applicant also respectfully disagrees with the Office Action's contention that Applicant did not attempt to point to where claims 21, 50 and 79 are supported in the specification. As indicated in its Reply to Office Action dated October 8, 2008, Applicant respectfully directs attention to the specification at, for example, page 31, lines 4-24, and Figures 7 and 8. These passages, in conjunction with the figures and pending claims, provide significant written description of the subject matter of independent claims 21, 50, and 79. More particularly, these passages disclose one exemplary embodiment of "an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals," as recited in amended independent claim 21, and similarly recited in amended independent claims 50 and 79.

The Office Action also contends that page 31 does not disclose "an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals." The Office Action contends that page 31 only discloses "a relationship between quality and time for a single goal, not multiple goals." *Id.* at page 34. Applicant respectfully disagrees, but also points to other locations in the specification that support the recited feature of "an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals."

Negotiating tradeoffs and making compromises between personal financial goals is discussed, *inter alia*, at page 13, line 7-9, page 29, lines 9-10. The impact of attaining goals on other goals is discussed at page 8, lines 3-9, page 12 and lines 27-31. "Whenever a change is made, adjustments are made to the goals. . . . [T]ypically adjustments result in one or more changes to other goals." Specification at page 33, lines 13-18. The "inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals" is shown clearly in the example presented on page 13, in which "a user . . . may want to upgrade [from a Camry] to a BMW. . . [T]he present invention readjusts other

goals and graphically shows these other goals becoming easier or harder to obtain. In this case example, the user sees that he or she may have to wait six more months for the car, and go to Disney World instead of Club Med this year.” Specification at page 13, lines 1-9. Thus, an increase in the quality of one goal (car) results in a decrease in quality of another goal (vacation).

The adjustment of goals and inverse relationship between quality and time indicia are also clearly seen in the description of a goal display in the specification beginning on page 40, in which an increase in quality in a car goal results in a different image of a vacation and the fading of the image of a house. The goal display shows the image of “the house . . . starting to fade away, that means we have to wait longer for it . . . and going camping when before we were going to Club Med. . . . [R]ais[ing] the priority of the vacation [results in] the house . . . getting either further away.” Specification at page 41, lines 1-25.

The Office Action contends that Figures 7 and 8 “are solid blocks of black and are completely illegible.” Office Action at page 3. Applicant respectfully disagrees. Applicant respectfully submits that, whether or not Figures 7 and 8 are in compliance with 37 CFR 1.84, Figures 7 and 8 are of a condition as to permit reasonable examination of the application. Applicants have never received an objection to Figures 7 and 8, nor has the Applicant received a requirement for corrected drawings.

According to the MPEP,

**If at the time of the initial assignment of an application to an examiner's docket, or if at the time the application is taken up for action, the supervisory patent examiner believes the drawings to be of such a condition as to not permit reasonable examination of the application, applicant should be required to immediately submit corrected drawings. However, if the drawings do permit reasonable examination and the supervisory patent examiner believes the drawings are of such a character as to render the application defective under 35 U.S.C. 112, examination should begin immediately with a requirement for corrected drawings and a rejection of the claims as not being in compliance with 35 U.S.C. 112, first paragraph, being made.**

MPEP 608.02(a) (Emphasis added). In addition,

Examiners should review the drawings for disclosure of the claimed invention . . .  
**. The examiners are directed to advise the applicants . . . in the first Office action** of the reasons why the drawings are not acceptable.

MPEP 608.02(b) (Emphasis added). Applicant respectfully submits that Applicant did not receive a requirement to submit corrected Figures 7 and 8 at the time of the initial assignment of an application to an examiner's docket, at the time the application is taken up for action, or in the first Office Action, which was dated March 11, 2003. The first Office Action did contain an objection to Figures 1 and 2a, not Figures 7 and 8, which Applicant resolved. The objection was withdrawn in the Office Action dated November 18, 2003. Applicant respectfully submits that the lack of an objection to Figures 7 and 8 or the lack of a requirement to correct the figures at the start of the prosecution raises an inference that the figures were then and are still in such a condition as to permit reasonable examination of the application.

Applicant further respectfully submits that, assuming *arguendo* that the Figures 7 and 8 are illegible, the text of the specification, as recited above and elsewhere in the specification, in conjunction with the pending claims, provides significant written description of the subject matter of all of the claims rejected under 35 U.S.C. § 112, ¶ 1, even without Figures 7 and 8. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, and 105-107 under 35 U.S.C. § 112, ¶ 1.

- **Claims 123-125**

Applicant also respectfully disagrees with the Office Action's contention that Applicant did not attempt to point to where claims 123-125 are supported in the specification. As indicated in its Previous Office Action Reply, Applicant directs attention to the specification at, for example, page 27, lines 26-27, page 28, line 27 through page 29, line 2, and Figure 6. These passages, in conjunction with the figures and pending claims, provide written description of the subject matter of dependent claims 123, 124, and 125. In particular, these passages disclose one exemplary embodiment of "generating a profile of the user based on the adjusted user preferences

and personal information of the user, wherein the personal information of the user includes information relating to one or more of the age of the user, the marital status of the user, the location wherein the user resides, and a number of children of the user,” as recited in amended claim 123, and similarly recited in amended claims 124 and 125.

The Office Action contends that page 27 of the specification does not disclose the above-recited feature. The Office Action contends that page 27 does not “convey possession of a profile generation device, it merely states that one is considered.” *Id.* at page 3. Applicant respectfully disagrees. Page 27 discloses that **“a profile is then generated on the user based on the adjusted preferences and the personal information of the user.”** Specification at page 27 (Emphasis added). Page 27 clearly discloses “generating a profile of the user” and that the profile is “based on the adjusted user preferences and personal information of the user” as recited in claim 123. In addition, Figure 6 supports the disclosure on page 27 by disclosing and operation 606 for **“GENERATING A PROFILE ON THE USER BASED ON THE ADJUSTED USER PREFERENCES AND THE PERSONAL INFORMATION OF THE USER.”** Figure 6 (Emphasis in original). The Office Action notes “the lack of any information as to how the input information . . . are converted into a profile [and] [n]o description as to how . . . data goes from information to profile is presented.” Office Action at page 3. Applicant respectfully submits that a person of ordinary skill in the art of developing the subject matter disclosed herein, namely “a network-based financial manager” (see specification at page 1, lines 8-9), would know how to generate a user profile, once he or she is presented with the idea of generating a user profile and the types of input information required by the profile, as the idea of generating a user profile and the types of information for the profile are presented in the specification at page 27, lines 26-27, page 28, line 27 through page 29, line 2, and Figure 6.

In conclusion, Applicant respectfully submits that the text of the specification, in conjunction with the figures and pending claims, provides significant written description of the subject matter of all of the claims rejected under 35 U.S.C. § 112, ¶ 1. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 123-125 under 35 U.S.C. § 112, ¶ 1.

**C. The Rejection under 35 U.S.C. § 102(e) Should be Withdrawn.**

For the reasons outlined below, Applicant respectfully traverses the rejection of claims 21-27, 50-56, 79-85, and 123-125 under 35 U.S.C. § 102(e) as being anticipated by *Jones*.

**1. The Pending Claims are not Anticipated by Jones.**

A proper anticipation rejection requires that “each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131. In addition, “[t]he elements must be arranged as required by the claim . . .” *Id.* (emphasis added). Applicant respectfully submits that *Jones* fails to disclose all of the subject matter recited in each of the independent claims 21, 50, and 79, and also fails to disclose the elements as arranged in the claims.

Specifically, *Jones* fails to disclose, *inter alia*,

- “displaying a plurality of images, each of the images representing a goal and at least one of the images comprising a picture”; and
- “graphically presenting to the user via the display device the impact of the adjustment on attaining the plurality of goals by again presenting simultaneously the image of the one of the selected goals as adjusted and the images of the remaining goals as impacted”; and
- “wherein graphically presenting the impact of the adjustment comprises altering the appearance of a picture associated with one of the remaining goals to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of the one of the remaining goals and to display an extent of the impact on the one of the remaining goals”;

as recited in amended independent claim 21.

Instead, *Jones* is directed to a financial advisory system to “return scenarios for optimized portfolio allocations [which] are simulated interactively to facilitate financial product selection.” *Jones*, 2:49-51. According to *Jones*, “[b]ased on the user’s current holdings the system may forecast a retirement income and graphically depict the current

portfolio's **projected growth and range of possible values over time.**" *Id.* at 6:3-6 (emphasis added). After an initial diagnosis is made in *Jones*, "[a]n iterative process may then begin in which the user may adjust his/her investment risk, savings rate, and/or retirement age and have the financial advisory system 100 evaluate the projected performance of an optimized portfolio given the financial products available to the user based on the currently selected risk tolerance, investment horizon and savings rate decisions." *Id.* at 6:20-27.

While the Board of Patent Appeals and Interferences, in its decision mailed February 28, 2008 (hereinafter, "Board Decision") for the subject application, states that "Jones contemplates the adjustment of preferences (e.g., savings) in the attainment of goals that is *not* limited to the 'adjustment of the *time* by which a goal would be attained' . . ." (pp. 14-15), such a teaching of *Jones* does not correspond to the currently pending recitations of independent claim 21. Indeed, *Jones* does not disclose "**displaying . . . images . . . representing [goals]** and at least one of the images comprising a **picture**" or "**altering the appearance of a picture** associated with one of the remaining goals to **reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the remaining goals and to display an extent of the impact on the one of the remaining goals**," as recited in independent claim 21 (emphasis added). Instead, *Jones* only discloses "graphically depict[ing] the current portfolio's **projected growth and range of possible values** over time." *Jones*, 6:3-6 (emphasis added).

The Office Action contends that *Jones* discloses at 6:3-13, 6:50-55, and 8:1-5 "**display[ing] outputs graphically**" by disclosing "the user adjust[ing] via a computer interface various goals in the form of risk levels, savings rates, and retirement ages," and that *Jones* discloses at 6:50-55 "**adjusting these goals.**" Office Action at 4. However, Applicant respectfully submits that the risk levels, savings rates, and retirement age disclosed by *Jones* at 6:3-13 and 6:50-55 are not disclosed as adjusted or impacted goals that are represented by "**a plurality of images, . . . at least one of the images comprising a picture**"; nor does *Jones* describe them as being displayed by

**“altering the appearance of a picture . . . to display an extent of the impact [of an adjustment] on . . . goals,”** as recited in amended claim 21.

*Jones* discloses risk levels and savings rates, not as goals, but as **actions** that a user may take **to achieve goals**. “The system may further advise the user regarding actions that may be taken (e.g., save more money, retire later, take on additional investment risk, seek opportunities to expand the investment set) to achieve certain financial goals . . . .” *Jones* 4:27-33. *Jones* also describes risk levels and savings rates as **“parameters”** (*Jones* at 6:27-31, emphasis added) and as **decision variables** that may be **adjusted**: “the user may again begin the iterative process of adjusting the decision variables described above (e.g., risk level, savings rate, and retirement age) until the user is satisfied with the likelihood of meeting his/her goal(s).” *Jones* at 6:51-55. However, nowhere in the cited sections of *Jones* nor elsewhere in *Jones* is there disclosure of risk levels or savings rates **goals** being adjusted.

As for retirement age, *Jones* only discloses “provid[ing] the user with statistics regarding the likelihood that they will be able to retire when they would like, given the projected returns on the user’s current portfolio based upon the data input by the user, including the user’s current savings rate, retirement age goal, and investment holdings” *Jones* at 6:7-12. Providing a user with statistics is not

- “displaying a plurality of images, each . . . representing a goal and at least one of the images comprising a picture”; and
- **“altering the appearance of a picture associated with one of the remaining goals to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of the one of the remaining goals and to display an extent of the impact on the one of the remaining goals.”**

as recited in independent claim 21 (emphasis added).

Accordingly, for at least the above-outlined reasons, *Jones* fails to disclose all of the subject matter recited in Applicant’s independent claim 21. Therefore, the rejection of independent claim 21 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn, and the claim should be allowed.

Applicant respectfully reminds the Examiner that the above-cited language was not present in the claims during the earlier appeal, and therefore was not before the Board.

Independent claims 50 and 79, although of different scope, include recitations that are similar to those discussed above with respect to independent claim 21. Thus, for at least the same reasons as discussed in connection with independent claim 21, Jones fails to disclose all of the subject matter recited in Applicant's independent claims 50 and 79. Therefore, the rejection of independent claims 50 and 79 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn, and the claim should be allowed.

Claims 22-39, 41-45, 47-49, and 123 depend from independent claim 21. Claims 51-68, 70-74, 79-78, and 124 depend from independent claim 50. Claims 80-97, 99-103, 105-107, and 125 depend from independent claim 79. For at least the same reasons as set forth above in connection with their corresponding independent claims, the rejection of claims 22-39, 41-45, 47-49, 51-68, 70-74, 79-78, 80-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 102(e) is legally deficient, should be withdrawn, and the claims should be allowed.

**2. The Board Opinion is Not *res judicata* to the Pending Claims.**

The Office Action mailed July 14, 2008 (hereinafter "Previous Office Action") contained a statement that the Board decision rendered the anticipation of elements recited in claims 25, 26, and 27 *res judicata*. See Office Action at 5. Applicant respectfully disputes application of *res judicata* to claims 25, 26, and 27 because the Board of Patent Appeals and Interferences was never presented with the current form of claims 25, 26, and 27, and therefore its ruling does not apply to claims 25, 26, and 27 as they are currently recited.

Claims 25, 26, and 27 depend from claim 21 and therefore include all the limitations thereof. Subsequent to the Board decision, independent claim 21 was amended to include recitations that have a scope different from the version of claim 21 that was pending before the Board decision. Therefore, current dependent claims 25, 26, or 27, depending from current claim 21, have a scope different from the versions of

dependent claims 25, 26, and 27 that were considered by the Board. Therefore, Applicant reiterates the contention outlined by Applicant in the Previous Office Action Reply that the Board of Patent Appeals and Interferences “did not rule on the elements of claim 21 as they are currently recited.” Previous Office Action Reply at 22. As such, the Board of Patent Appeals and Interferences also did not rule on the elements of claims 25, 26, and 27 as they are currently recited. Thus, the reliance on *res judicata* rendering anticipated elements recited in claims 25, 26, and 27 is a misapplication of the Board’s decision.

In the Office Action, the Examiner implied that the narrow element recited in claims 25, 26, or 27 anticipated the broader version of the claim element as it was recited in claim 21 because of *res judicata*. “If *res judicata* applies to a narrow element, it automatically applies to the broader version of itself. The narrow element anticipates the broader version of itself.” Office Action at p. 5. However, Applicant respectfully submits that, even assuming *arguendo* that the broader version of the claim element in claim 21 was anticipated by the “adjustment to the time indicia” element recited in claim 25, the “adjustment to the quality indicia” element recited in claim 26, or the “adjustable indicia of favoritism between time and quality” element recited in claim 27, pending claim 21 as a whole, as it is currently amended, is still not rendered anticipated through *res judicata* because it has been amended to contain the recitations identified above that were not before the Board of Patent Appeals and Interferences.

There are clear differences in the claims considered by the Board and the currently pending claims. For example, the Board did not consider the claim elements:

- “displaying a plurality of images, each . . . representing a goal and at least one of the images comprising a picture”; and
- “altering the appearance of a picture associated with one of the remaining goals to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of the one of the remaining goals and to display an extent of the impact on the one of the remaining goals.”

Therefore, the Office Action’s application of *res judicata* in this application is legally unsupportable. The Board did not rule on the current recitations of independent claim 21, nor on any claims depending therefrom, and the Office Action cannot rely on

the doctrine of *res judicata* to reject independent claim 21 nor on any claims depending therefrom.

**D. The Rejection under 35 U.S.C. § 103(a) Should be Withdrawn.**

Applicant respectfully traverses the rejection of claims 28-39, 41-45, 47-49, 57-68, 70-74, 76-78, 86-97, 99-103, and 105-107 under 35 U.S.C. § 103(a) as being unpatentable over the *Jones* reference because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8<sup>th</sup> Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted). In addition, when “determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

In this application, a *prima facie* case of obviousness has not been established because, among other things, *Jones* does not teach or suggest each and every feature of Applicant’s independent claim 21, from which claims 28-39, 41-45, and 47-49 depend.

Because claims 28-39, 41-45, and 47-49 depend directly or indirectly from claim 21, they include all the limitations thereof. As discussed above, *Jones* fails to disclose or suggest, *inter alia*,

- “displaying a plurality of images, each of the images representing a goal and at least one of the images comprising a picture”; and
- “graphically presenting to the user via the display device the impact of the adjustment on attaining the plurality of goals by again presenting simultaneously the image of the one of the selected goals as adjusted and the images of the remaining goals as impacted”; and
- “wherein graphically presenting the impact of the adjustment comprises altering the appearance of a picture associated with one of the remaining goals to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of the one of the remaining goals and to display an extent of the impact on the one of the remaining goals”;

as recited in amended independent claim 21.

Therefore, for at least the reasons stated above with respect to claim 21, *Jones* also fails to disclose or suggest the missing elements in claims 28-39, 41-45, and 47-49. a *prima facie* case of obviousness for claims 123-126 and 130-133, which depend directly or indirectly from claim 120 and therefore include all the limitations thereof, has not been established. *Jones, neither alone or in combination with the elements of claims 28-39, 41-45, and 47-49, fails to teach or suggest each and every element of the claims as amended.* In addition, no additional evidence has been raised establishing a tenable rationale why one of ordinary skill would have been motivated to modify *Jones* so as to arrive at the claimed invention.

- With respect to the rejection of claim 28, the Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to present tailored advertisements . . . with a stored profile . . . **in order to increase the accuracy of displaying ads** to users to which options of the ad are available.” See Office Action at 14 (emphasis added).
- With respect to the rejection of claim 41, the Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include presenting the providers that provide the options of *Jones* et al (such as for the different mutual funds discussed) **in order to increase the accuracy of planning for the goals of the user by**

**accurately presenting all of the options available to the user.”** See Office Action at 20 (emphasis added).<sup>5</sup>

At best, the Office Action’s assertions could be considered assertions that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining the elements recited in claims 28-39, 41-45, and 47-49 into *Jones* would not result in a predictable variation of the invention recited in claims 28-39, 41-45, and 47-49 because *Jones* would still lack the elements recited in claim 21. Because it would lack recited elements of Applicant’s invention, it would not be a predictable variation of Applicant’s invention.

Accordingly, neither *Jones*, nor any obvious variant thereof, discloses or suggests at least the above-noted elements of independent claim 21, from which claims 28-39, 41-45, and 47-49 depend. Therefore, independent claim 21 is nonobvious over *Jones* under 35 U.S.C. 103(a), and should be allowed. Claims 28-39, 41-45, and 47-49 are also nonobvious over *Jones* at least because of their dependence from nonobvious independent claim 21.

Claims 57-68 and 70-78 depend from independent claim 50. Claims 86-97, 99-103, and 105-107 depend from independent claim 79. Independent claims 50 and 79, although of different scope, recite elements similar to those discussed above with respect to independent claim 21. For at least the same reasons as discussed in connection with claims 28-39, 41-45, and 47-49, the Office Action has also not established *prima facie* obviousness regarding claims 50, 57-68, 70-79, 86-97, 99-103, and 105-107. Independent claims 50 and 79 are nonobvious over *Jones* under 35 U.S.C. 103(a), and should be allowed. Claims 57-68, 70-78, 86-97, 99-103, and 105-

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<sup>5</sup> Applicant notes that the options such as the mutual funds of *Jones* referred to in the Office Action at page 20, are “investment options,” also called “available financial products” (see *Jones* at 1:26-30, and at 6:50-55). The investment options are not “goal options,” nor do they comprise “an expected quality of [a] selected goal,” as now recited in amended claim 41.

107 are also nonobvious over *Jones* at least because of their dependence from nonobvious independent claims 50 and 79.

The Office Action asserted that Applicant's arguments in the Previous Office Action Reply failed to comply with 37 CFR 1.111(b) because they did not "specifically [point] out how the language of the claims patentably distinguishes them from the references." Applicant respectfully disagrees with the Office Action's characterization of Applicant's arguments in the Previous Office Action Reply, but herein specifically points out that the claims 21, 50 and 79, from which the claims rejected for allegedly being obvious depend, are patentably distinguished from *Jones* because they recite the above-quoted new, useful and non-obvious elements, which are missing from *Jones*.

In particular, as discussed above, *Jones* lacks the element, "displaying a plurality of images, each of the images representing a goal and at least one of the images comprising a picture" as recited in amended claim 21. Because *Jones* does not disclose "displaying . . . images representing a goal and at least one of the images comprising a picture," it would not be obvious, in view of *Jones*, to "graphically [present] to the user . . . the impact of the adjustment on attaining the plurality of goals by again presenting simultaneously. . . images" or by "altering the appearance of a picture associated with one of the remaining goals to . . . display an extent of the impact [of the goal adjustment] on the one of the remaining goals" as recited in amended claim 21. Therefore, claim 21, from which the claims rejected for allegedly being obvious, recites new, useful and non-obvious elements that are missing from *Jones*.

Because claim 21 is patentably distinguished from *Jones*, the claims which depend directly or indirectly therefrom are also patentably distinguished from *Jones*. Claims 50 and 79, although different in scope, recite similar features and therefore, therefore, claims 50 and 79 also are patentably distinguished from *Jones*, and the claims which depend directly or indirectly therefrom are also patentably distinguished from *Jones*.

#### IV. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the cited art.

Applicant submits that the proposed new claims 126-134 do not necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships as claimed were either earlier claimed or inherent in the claims as examined.

Applicant therefore requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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